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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,871

07/27/2005

Thomas Goebel

H-32814A

6784

74479

7590

08/10/2009

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EXAMINER

SCHLENTZ, NATHAN W

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

08/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/537,871	<b>Applicant(s)</b> GOEBEL ET AL.	
	<b>Examiner</b> Nathan W. Schlientz	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-35 is/are allowed.
- 6) ☒ Claim(s) 21, 23, 24, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 22, 25 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Allowable Subject Matter***

The indicated allowability of claims 21, 26 and 27 is withdrawn in view of the rejection herein below.

### ***Renumbering of the Claims***

Applicant's claims filed on 07 June 2005, 11 August 2005, and 04 August 2008 omitted claim 35 from the claim listings. All of the claims presented in a claim listing shall be presented in ascending numerical order. See 37 CFR § 1.121. Therefore, claims 36 and 37 are renumbered herein as claims 35 and 36, respectively.

### ***Status of the Claims***

Claims 21-35 are pending in the present application and are examined herein on the merits for patentability.

### ***Withdrawn Rejections***

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

***Claim Rejections - 35 USC § 102***

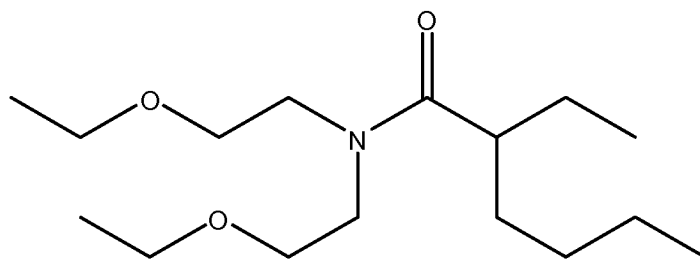
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 21, 23, 24, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mod et al. (US 3,309,333; US 3,515,754; US 3,519,661; US 3,538,123; and US 3,584,030).

Mod et al. disclose N,N-bis(2-ethoxy)-2-ethylhexanamide (depicted below wherein R= CH(C<sub>2</sub> alkyl)(C<sub>4</sub> alkyl); X and Y= C<sub>2</sub> alkyl; and R1 and R2= C<sub>2</sub> alkyl) prepared by reacting di(2-ethoxyethyl)amine and 2-ethylhexanoyl chloride (Example 4 in all patents listed above). Mod et al. disclose the compound eluted with a 1:1 ethanol-benzene mixture (Example 4). The instant specification lists benzene as a suitable diluents (pg. 6, ln. 1-11), and states that the compounds are used in diluted form with simple alcohols, such as ethanol (pg. 11, ln. 16-20).



*N,N*-bis(2-ethoxyethyl)-2-ethylhexanamide

It is noted that the recitation of the intended use “vermin-repellent” has not been given patentable weight to distinguish over Mod et al. because the intended use of the

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claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Since Mod et al. discloses compounds that are the same as those claimed, in the absence of evidence to the contrary they would be capable of performing the intended use, as claimed.

It is also noted that Mod et al. does not explicitly disclose that the composition is a “pour-on” formulation. However, the composition comprises N,N-bis(2-ethoxy)-2-ethylhexanamide in a 1:1 ethanol-benzene mixture, which would inherently be pourable.

### ***Response to Arguments***

Applicants argue on page 6 that they amended claims 23 and 24 to depend from allowed claim 21, which was amended to dependent form, thus overcoming the rejection. However, claim 21 was inadvertently omitted from the previous rejection. As can be clearly seen in the above rejection, Mod et al. discloses a composition comprising N,N-bis(2-ethoxy)-2-ethylhexanamide in a 1:1 mixture of ethanol and benzene. Therefore, Mod et al. clearly anticipate claims 21, 23, 24, 26 and 27.

### ***Allowable Subject Matter***

Claims 22, 25 and 28 are objected to as being dependent upon a rejected base claim (claim 21), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 29-35 are allowed.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Schlientz whose telephone number is (571)272-9924. The examiner can normally be reached on 9:00 AM to 5:30 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWS

/Johann R. Richter/  
Supervisory Patent Examiner, Art Unit 1616